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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,991	08/31/2000	Donald L. Yates	MTI-31046	4383

31870 7590 07/16/2002

WHYTE HIRSCHBOECK DUDEK S.C.
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SUITE 2100
MILWAUKEE, WI 53202

EXAMINER

TRAN, BINH X

ART UNIT	PAPER NUMBER
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1765

6

DATE MAILED: 07/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application

09/652,9

Examiner

Binh X Tran

Applicant(s)

ATES, DONALD L.

Unit

Address address --

-- The MAILING DATE of this communication appears on the cover sheet.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. 1.131(d)).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce an applicant's earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2002.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,12-14,20,21,26-35 and 76-141 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,12-14,20,21,26-35 and 76-141 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Part of Paper No. 6

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1: at least hydrofluoric acid and the one or more organic acid in a ratio of about 2:1(v/v).

Species 2: hydrofluoric acid and an organic acid in a ratio of about 1:2 (v/v).

Species 3: at least ammonium fluoride and the one or more organic acids in a ratio of about 2:1(v/v).

Species 4: organic fluorine compound and inorganic acid compound in a ratio of 1:5 (v/v).

Species 5: inorganic fluorine compound and an organic acid in a ratio of about 1:100 (v/v).

2. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 12, 26, 31, 79 are generic.
3. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

4. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).
5. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.
6. Claims 20, 26, 88 are generic to a plurality of disclosed patentably distinct species comprising "an inorganic fluorine-comprising compound selected from the group consisting of hydrofluoric acid and ammonium fluoride, and mixture thereof; an organic acid selected from the group consisting of citric acid, acetic acid, ascorbic acid and mixture thereof". Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.
7. Claim 33 is generic to a plurality of disclosed patentably distinct species comprising "an inorganic fluorine-comprising compound selected from the group consisting of hydrofluoric acid and ammonium fluoride, and mixture thereof"; and "organic acid selected from the group consisting of citric acid, gallic acid, acetic acid, formic acid, propionic acid, n-butyric acid, isobutyric acid, benzoic acid, ascorbic acid,

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gluconic acid, malic acid, malonic acid, oxalic acid, succinic acid, tartaric acid and mixture thereof". Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

8. Claims 34, 78, 118 are generic to a plurality of disclosed patentably distinct species comprising "the organic acid is selected from the group consisting of citric acid, acetic acid, ascorbic acid and mixture thereof". Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

9. Claims 76, 86, 116, 119, 120, 132, 133 are generic to a plurality of disclosed patentably distinct species comprising "an inorganic fluorine-comprising compound selected from the group consisting of hydrofluoric acid and ammonium fluoride, and mixture thereof". Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

10. Claims 77, 87, 117 are generic to a plurality of disclosed patentably distinct species comprising "organic acid selected from the group consisting of citric acid, gallic acid, acetic acid, formic acid, propionic acid, n-butyric acid, isobutyric acid, benzoic acid, ascorbic acid, gluconic acid, malic acid, malonic acid, oxalic acid, succinic acid, tartaric acid and mixture thereof". Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

11. Claims 99, 101, 106 are generic to a plurality of disclosed patentably distinct species comprising "organic fluorine-comprising compound is selected from the group consisting of hydrogen fluoride pyridinium, tetramethylammonium fluoride,

triethylamine trihydrofluoride, and mixture thereof". Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

12. Claim is 103 generic to a plurality of disclosed patentably distinct species comprising "organic fluorine-comprising compound is selected from the group consisting of hydrogen fluoride pyridinium, tetramethylammonium fluoride, triethylamine trihydrofluoride, and mixture thereof; and the inorganic acid selected from the group consisting of sulfuric acid, nitric acid, hydrochloric acid, phosphoric acid, and mixture thereof". Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

13. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh X Tran whose telephone number is (703) 308-1867. The examiner can normally be reached on Monday-Thursday and every other Friday.

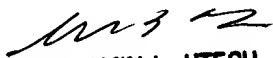
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin L Utech can be reached on (703) 308-3836. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Binh X. Tran
July 12, 2002


BENJAMIN L. UTECH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700